

The opinion in support of the decision being entered today was **not** written for publication in a law journal and is **not** binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT M. COLEMAN

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Appeal No. 98-1474  
Application No. 08/579,385

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ON BRIEF

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Before JERRY SMITH, FLEMING, and BARRY, Administrative Patent Judges.

BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the rejection of claims 1 and 3. We reverse.

BACKGROUND

The invention at issue in this appeal relates to digital color printing in which gray objects and color objects are both printed. Gray can be specified by a page description language to be printed in either black colorant or in process

black, which is a combination of cyan, magenta, yellow, and black (C, M, Y, K). Black colorant has a different gloss than process black. Accordingly, a more pleasing print will be made if process black is used over a colored (i.e., a C, M, Y) background and black colorant is used over a white or gray background. Also, process black exhibits slight edges of C, M, Y color if its layers of color are not perfectly aligned. Such edges are obvious over a gray or white background not over a colored background.

Claim 1, which is representative for our purposes, follows:

1. In a system which uses electronic signals to specify black and non black colorants to be used in a printing process to print a grey area over a background area, a method for determining colorants to be used to print said grey area comprising the steps of:

testing said signals to determine if the background is to be printed using a non black colorant,

if a non black colorant is to be used to print the background, generate a signal specifying that said grey color will comprise a non black colorant, and

printing said grey area.

The reference relied on in rejecting the claims follows:

Bollman et al. (Bollman)	5,289,297	Feb.
22, 1994.		

Claims 1 and 3 stand rejected under 35 U.S.C. § 103(a) as obvious over Bollman. Rather than repeat the arguments of the appellant or examiner in toto, we refer the reader to the briefs and answer for the respective details thereof.

#### OPINION

In deciding this appeal, we considered the subject matter on appeal and the rejection advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellant and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 1 and 3. Accordingly, we reverse.

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir.

1992).... "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With these principles in mind, we address the examiner's rejection and the appellant's argument.

The examiner makes the following assertion.

Bollman teaches ... testing signals to determine if the background uses non-black colorant. This is described in the determining step 250 as taught at col. 6, lines 38-43, where it states that determination is made as to whether each color in the LUT, as determined by the area which has been designated, as being a foreground color or background color; and if a non-black colorant is used in the background, then the grey value will consist of non-black colorant, i.e., a value more than the densest value of each of the r, g and b components of the system, see col. 6, lines 8-13.

(Examiner's Answer at 4-5.) The appellant argues, "in Bollman it is the density of colorants in the background that is being tested against a reference level, while in this application it is the presence of non black colorant of any density that is

tested for. Testing for the existence of a non-black colorant (of any density) and testing whether the background is above or below a density reference do not read on one another."  
(Appeal Br. at 4.)

``[T]he main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. [T]he name of the game is the claim ....'" In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) (quoting Giles S. Rich, The Extent of the Protection and Interpretation of Claims--American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990)). Here, claim 1 and 3 specify in pertinent part the following limitations: "[i]n a system which uses electronic signals to specify black and non black colorants to be used in a printing process to print a grey area over a background area, ... testing said signals to determine if the background is to be printed using a non black colorant ...." Accordingly, the limitations require testing signals indicating both black and non black colorants to

determine if a background is to be printed using a non black colorant.

The examiner fails to show a suggestion of the limitations in the prior art. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995)(citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." Id. at 1266, 23 USPQ2d at 1784, (citing In

re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

Here, the examiner alleges that Bollman teaches testing signals to determine if the background uses non-black colorant at column 6, lines 38-43. (Examiner's Answer at 4-5.) The reference, however, belies the allegation. Although Bollman teaches testing signals specifying colorants, the signals do not indicate black colorants, and the testing does not determine if a background is to be printed using a non black colorant. To the contrary, the signals indicate only non black colorants, viz., red, green, and blue (r, g, b). Col. 6, l. 41. Further to the contrary, the testing determines whether a pixel is in the foreground or the background. Specifically, "at step **250**, a determination is made as to whether each color the look up table color in the selected area is a background or foreground color ...." Id. at ll. 39-41.

Because Bollman teaches indicating only non black colorants and determining whether a pixel is in the foreground

or the background, we are not persuaded that teachings from the prior art would have suggested the limitations of "[i]n a system which uses electronic signals to specify black and non black colorants to be used in a printing process to print a grey area over a background area, ... testing said signals to determine if the background is to be printed using a non black colorant ...." The examiner fails to establish a prima facie case of obviousness. Therefore, we reverse the rejections of claims 1 and 3 as obvious over Bollman.

#### CONCLUSION

In summary, the rejection of claims 1 and 3 under 35 U.S.C. § 103(a) is reversed.



REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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LANCE LEONARD BARRY	)	
Administrative Patent Judge	)	

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RONALD ZIBELLI  
XEROX CORPORATION  
XEROX SQUARE 020  
ROCHESTER NY 14644

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APPLICATION NO. 08/579,385

APJ BARRY - 2 copies

APJ JERRY SMITH

APJ FLEMING

DECISION: **REVERSED**

Prepared By: APJ BARRY

**DRAFT SUBMITTED:** 20 Sep 01

**FINAL TYPED:**

Team 3:

I have typed almost all of this opinion.

Please provide insertions where needed including the mailing address.

Please check spelling, cites, and quotes.

**Do NOT change matters of form or style.**